

REMARKS/ARGUMENTS

Claims 1-23 are pending in the application. Claims 1-6 and 10-17 are withdrawn from consideration, in view of a Restriction Requirement. No claims have been amended, added, or cancelled with the filing of this Response.

Applicant acknowledges the Office's renumbering of claims 17-22 as claims 18-23.

Reconsideration of the claimed invention is requested in view of the following remarks.

Rejection under 35 U.S.C. § 103

The rejections of claims 7, 9 and 18-22 under 35 U.S.C. § 103(a) as obvious over Johnson (US Patent No. 4,098,941) and further in view of Glück et al. (US Patent No. 6,340,713); and claims 8 and 23 as obvious over Johnson and further in view of Glück et al. and Tung et al. (US Patent No. 6,214,897) are respectfully traversed for reasons of record and below.

As the Office is aware, it is well settled that rejections under §103(a) must comply not only with the statutory provisions of §103, but also with the controlling case law. MPEP §2141, informing that it is Office policy to follow the teachings of *Graham*.) Notably, an obviousness analysis requires consideration of the *Graham* factual inquiries, which include, *inter alia*: (A) determining the scope and contents of the prior art; and (B) ascertaining the differences between the prior art and the claims in issue. (*See, KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734-1740 (2007), citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); see also *In re Ward and Murphy*, Appeal No. 2007-3733 (explaining that an obviousness determination requires that the Office make “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.”).

In the present case, as noted in the previous response, a comparison clearly shows that Johnson only describes a means for the production of a polystyrene foam extrudate, and not the resulting expandable pelletized thermoplastic polymer material of the claimed invention. As indicated in the present Office Action at pages 3-4 and in the Response to Arguments, Johnson further mentions several components that *may* be added during its process. However, Applicant points out that these components are used in the document's object of forming a strong and rigid polystyrene foam product.

In fact, Johnson clearly emphasizes that the disclosed extrudate is distinguished from other patents “by its ability to very precisely control the cooling conditions of a particular thermoplastic, polystyrene foam, so as to greatly enhance that materials’ strength properties. The present invention utilizes the unusual properties of a particular coolant to produce a unique polystyrene foam extrudate having a density gradient of decreasing value from the outside surface to the core.” Column 2, lines 15-19.

As also appreciated by the Office, Johnson does not describe the combinations of components of all of the present claims. Moreover, Glück et al. and Tung et al. are clearly deficient. In particular, Glück et al. does not provide any guidance for formulating an expandable palletized thermoplastic polymer with the presence of the claimed fillers. Further, Tung et al. only describes a semi-semi-crystalline polycondensed branched polyester polymer blended with an aromatic polycarbonate. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (indicating that prior art references must be considered in their entirety, as a whole, including any disclosures that lead away from the claims at issue). As such, one would not rely on or have an apparent reason to modify Johnson to achieve the claimed invention.

Therefore, for at least these reasons, withdrawal and reconsideration of the rejection are respectfully requested.

CONCLUSION

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

In the event the Examiner believes an interview might serve in any way to advance the prosecution, the undersigned is available at the telephone number noted below.

If any fees are due with the filing of this Response, please charge our Deposit Account No. 03-2775, under Order No. 12810-00267-US from which the undersigned is authorized to draw.

Dated: January 27, 2010

Respectfully submitted,

Electronic signature: /Bryant L. Young/
Bryant L. Young
Registration No.: 49,073
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant